

REMARKS

I. Status of the Claims

Claims 1-10, 12-18, 20-34, and 37-44 are pending. Claims 13, 15, 23-29, and 37-44 have been withdrawn as directed to a non-elected invention/species. No claim amendments are submitted with this response.

II. Examiner Interview

Applicants wish to thank Examiner Wang for the courtesies extended to their representatives, Louis Troilo and Adriana Burgy, during the interview of August 18, 2004. Further to the discussions during the interview, Applicants present the following remarks for the Examiner's consideration.

III. Rejection Under 35 U.S.C. § 103(a)

The Office maintains the rejection of claims 1-10, 12, 14, 16-18, 20-22, and 30-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,482,704 to Sweger et al. ("Sweger") and U.S. Patent No. 6,277,893 to Babenko ("Babenko") in view of U.S. Patent No. 5,919,438 to Saint-Leger ("Saint-Leger") and U.S. Patent No. 5,720,964 to Murray ("Murray"). Office Action at pages 2-4. Applicants respectfully disagree and traverse this rejection for the reasons of record and the following additional reasons.

The Office continues to maintain that "nowhere in Sweger et al. teach the cosmetic composition therein has to comprising [sic] fatty acid soap." Office Action at page 4. Contrary to the Office's position, it is well-known that "a reference[, however,] must be considered not only for what it expressly teaches, but also for what it fairly

suggests.” *In re Burckel*, 201 U.S.P.Q. 67, 70 (C.C.P.A. 1979). In this case, Sweger exemplifies compositions comprising fatty acid soap and the Office directs Applicants’ attention to Example VI, wherein stearic acid and triethanolamine are utilized and form fatty acid soap. See Office Action dated September 17, 2003, at page 3. This is in contrast to the claimed invention which recites, among other things, “wherein said composition is free of fatty acid soaps.” See claim 1. As such, the combination of references, among other things, fail to teach all the claim limitations. See M.P.E.P. § 2143 (8th ed. Rev. 2, 2004).

Furthermore, the Office continues to rely on the secondary references (Murray & Saint Leger) to teach “well-known cosmetic ingredients.” Office Action dated May 24, 2004 at page 5, ll. 13-18. According to the Examiner, “[i]ncorporating those ingredients with the amphoteric starch herein to form a cosmetic composition, such as shampoo, would have been obvious to one of ordinary skill in the art.” *Id.* Applicants continue to disagree.

The Federal Circuit has recognized that “virtually all inventions are combinations and virtually all are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983). In fact, the Federal Circuit in *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998), explained that very often an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient enough to negate patentability. 47 U.S.P.Q.2d at 1457. Instead, the court stated that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner

claimed.” *Id.* As such, a suggestion or motivation to combine the references may come from “the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem to be solved.” *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 37 U.S.P.Q.2d 1626, 1630 (Fed. Cir. 1996). However, the Office fails to carry the burden of establishing an objective teaching or suggestion to combine the two primary references with the two secondary references. More specifically, there are at least the following deficiencies in the Office’s position.

The Office relies on a motivation and/or suggestion that provides “all these ingredients are old and well-known cosmetic ingredients, particularly in shampoo compositions.” Office Action dated May 24, 2004 at page 4, ll. 6-10. This rationale does not amount to objective evidence to suggest or motivate the combination. Instead, it is based on mere conjecture, which does not suffice under Section 103 as noted in *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993) and found in Section 2143 of the M.P.E.P., which states that

[a] statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima-facie case of obviousness without some objective reason to combine the teachings of the references.

See M.P.E.P. § 2143 (emphasis original).

Moreover, under the Office’s rationale, a person of ordinary skill in the art would have to pick and choose from among at least the following to arrive at the presently claimed invention:

- (1) Look to Sweger and Babenko to teach a cosmetic composition comprising the claimed amphoteric starch;
- (2) In Sweger, ignore the particular teachings that recite ingredients generating fatty acid soaps, e.g., Example 6, although Sweger fails to provide any guidance or selection criteria to do so;
- (3) In Babenko, ignore the particular teachings directed to surfactants or emulsifying agents. For example, this reference teaches emulsions containing a cationic polysaccharide and dimethicone copolyol in an oil phase but ignore the express assertion that “classical type surfactants or emulsifying agents [which] can cause skin irritation or allergic reactions and [also] may not be compatible with other constituents in the emulsion formulation” to incorporate the washing base, such as a surfactant, into the composition (Babenko at Col. 1, ll. 28-32); and
- (4) Look to the secondary references of Saint-Leger and Murray for the specific cosmetic ingredients of alkyl ether sulfate, and the particular cationic polymer, polydimethylsiloxane and coconut misisopropanolamide, despite no clear direction, except that provide by Applicants’ disclosure. According to the Office’s rationale, the combination of Sweger and Babenko would preclude any invention using a combination of “old and well-known cosmetic ingredient”. The Federal Circuit has repeatedly railed against such a rationale. See, e.g., *Environmental Designs, Ltd.*, 218 U.S.P.Q. at 870, and *In re Rouffet*, 47 U.S.P.Q.2d at 1457.

More generally, “[i]t is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965). In essence, the Office’s rejection is based on selective picking and choosing from each of several references in order to create the claimed invention, while impermissibly ignoring the art as a whole.

Furthermore, in the Office Actions dated September 7, 2003 and April 9, 2003, and now in the Office Action dated May 24, 2004, the Office asserts that “starch derivatives have excellent aesthetic properties of skin feel and appearance and are superior to conventional thickener or emulsion stabilizer” to motivate the use of starch derivatives as emulsion stabilizers or thickeners as taught in Sweger and Babenko. In this instance, the Office fails to explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination with Saint-Leger and Murray. Instead, the Office relies on general properties achieved by a specific ingredient, i.e., the starch derivatives.

As such, the references appear to separately teach individual elements of the claimed invention; however, no reference appears to teach or suggest the combination of the recited components from amongst all the possible components for use in a cosmetic composition. Accordingly, Applicants respectfully request the withdrawal of this rejection.

IV. Conclusion


In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Adriana L. Burgy
Reg. No. 48,564